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IN THE
Supreme Court of the United States

OCTOBER TERM, 1949.

No. 19.

TODD C. FAULKNER, *Petitioner*,

v.

JOHN T. GIBBS, *Respondent*.

REPLY BRIEF FOR TODD C. FAULKNER,
Petitioner.

ROBERT W. FULWIDER,
Attorney for Petitioner.

JAMES P. BURNS,
Of Counsel.

of elements 2 and 3' ~~is feature not present in Petitioner's game.~~

Regarding the validity of Claims 6-10, Respondent merely says (page 51) that "by analogy (to Claim 3) the other claims in suit also define valid combinations." *Nothing more is said!*

Respondent has refused to face the fact that Claims 6-10 are even *more functional* than Claim 3, and in particular that said claims are functional at their exact point of novelty. As discussed in detail in our Opening Brief, the only feature of novelty in Claims 6 to 10 is the function resulting from the interconnection of the individual game units. *This function and various ways of attaining it are fully disclosed by the prior art patents on competitive games.*

Furthermore, we see that Claim 6 in describing the individual game units, neglects to state that they include a game board, *or* holes, *or* balls to pass through the holes, *or* any particular kind of indicator, *or* that the indicators correspond in arrangement with the contact devices, *or* any particular type of contact device, *or* any location for the contact device, *or* "means" for energizing the indicators.

Claim 6 as to the individual game units reads squarely on Nakashima.

The only element of Claim 6 not shown by Nakashima, is the "means" for connecting the game units together whereby when a win is accomplished on one unit the other units are disconnected. No details or structure are given as to how this function is to be accomplished. *The function is old, only the detailed structure, not defined, could possibly lend patentability to the Gibbs game.*

Claim 9 is almost identical with Claim 6 except that unlike Claim 6 it specifies a game board with holes therein. It likewise depends upon functional statements at its exact point of novelty.

As to the means for interconnecting the units, Respondent asserts that Claim 9 is broader than Claim 6. However

it actually is slightly narrower than Claim 6 since it attempts to tie the means for disconnecting the non-winning units to the signal circuit of the winning unit. But again no *structure* is described and from a casual inspection of the competitive game patents of the prior art (*none of which were cited by the Patent Office during the prosecution of the Gibbs patent*), it is seen that numerous circuits and structures were known in the art for accomplishing this function recited in both Claims 6 and 9.

Thus we see that Claims 6-10 are clearly defective, since the only feature of novelty therein over the prior art is described in functional terms as "means for de-energizing" and "means for discontinuing" the circuits on the non-winning units.

As stated by Mr. Justice Reed in the case of *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 61 U.S.P.Q. 382,

"But the quid pro quo is disclosure of a process or device in sufficient detail to enable one skilled in the art to practice the invention once the period of the monopoly has expired; and *the same precision of disclosure* is likewise essential to *warn industry* concerned of the *precise scope* of the monopoly asserted. *Bene v. Jeante* 129 U.S. 683, 685; *General Electric v. Wabash Corp.* 304 U.S. 364.

• • • • The claim is the measure of the grant. *Smith v. Snow* 294 U.S. 1, 11. *The claim is required to be specific* for the very purpose of *protecting the public* against the extension of the scope of the patent. *White v. Dunbar* 119 U.S. 47, 52; *Minerals Separation v. Boot, etc. Mining Co.* 250 U.S. 336, 347; *Knick v. Bowes Sealfast Corp.* 25 F. (2d) 442." (Emphasis added).

An outstanding instance of findings herein so clearly erroneous as to warrant this court in reviewing the same is Finding XII (R 37, 38) which is in *direct conflict* with the trial court's holding in this case.

The trial court held that Petitioner's new Fawn game did *not* infringe claims 6, 7 and 8 because it did *not* have means operative upon a win being made on one game unit for disconnecting the non-winning units as called for by Claim 6. However, the trial court then through palpable error (R 289) found (see top of R 38) that the new Fawn game infringed claims 9 and 10 which contain the same element, to wit; means operative upon a win being made on one game unit for disconnecting the non-winning units.

Such findings illustrate the character of error committed by the courts below that support Petitioner's contention that the findings herein come within the *exception to the rule* and should be set aside by this court as *clearly erroneous*.

Respondent Ignores His Claims in His Treatment of the Other Prior Art Patents.

In discussing the prior art patents other than Nakashima, Respondent calls attention to various features of the game illustrated in the Gibbs patent *drawings*. What Respondent does *not* say, however, is that almost without exception *none* of these features is included in any of the Gibbs claims *here in suit*.

For example, in discussing the Hayashi patent at page 24 of his Brief, Respondent calls attention to the fact that Hayashi's playing board is inclined downwardly away from the player instead of upwardly as in Gibbs. However, *none of the Gibbs claims even mentions* inclination of the game board. As a matter of fact, Claims 6, 7 and 8 don't even call for a board.

Respondent further states that Hayashi provides *three* "objects" in the form of peanuts to be rolled across the board. What Respondent does *not* state, however, is that *because of the broad functional wording of the Gibbs claims*, they cover using peanuts as well as balls, ~~and~~ nothing at all is said *in the claims* with respect to the path which has to be followed by said "objects". Respondent complains

that the weighted peanuts of Hayashi remain in the pockets in order to keep the indicators energized. But there is nothing in Gibbs' *claims* which states that his "objects" *must pass through the board.*

The same is true as to the Esmarian patent. Respondent calls attention to the fact that Esmarian uses a plurality of balls which remain in the pockets. But there is *nothing* in any of the Gibbs *claims* which limits them to a *single ball or to a board having pockets therein through which the balls may pass.* The "object" is *not even an element of the Gibbs game, per se, nor is it recited as a positive element in any of the claims.*

With respect to the Mader patent, Respondent neglects to say that it shows an annunciator panel *practically identical* with the Gibbs annunciator *having vertical and horizontal rows* of lights which are energized when their corresponding indicators are engaged by a ball rolled across the board.

In discussing the prior art patents to Chester, Wallace, Higuchi Prina and Irseh, the Respondent attempts to minimize the disclosures of these patents by saying that they do not show game boards. However, all of these competitive game patents show the Gibbs system of interconnecting a plurality of game units in such a manner that a win in one unit disconnects all of the others. These patents are of particular interest because the Patent Office *did not cite any competitive game patents whatsoever* against the Gibbs application. If even one such patent had been found by the Examiner, he obviously would never have allowed claims 6-10 in their present broad *functional form.*

The Cases Cited by Respondent When Correctly Construed Support Petitioner's Position Herein.

Under the sub-title "Fundamental Supreme Court Doctrine", pages 40-45 of his Brief, Respondent quotes from a few Supreme Court cases, and at page 47 he makes an out-

line of the claims adjudicated in said cases. Turning first to the case of *Bates v. Coe*, 98 U. S. 31, quoted by Respondent, we find that Mr. Justice Clifford stated that a claim to a combination of old elements was proper:

...of the elements or devices of which it is composed are all named and their mode of operation given, and the new and useful result to be accomplished pointed out, so that those skilled in the art and the public may know the extent and nature of the claim.

(Emphasis added.)

The foregoing definition of combination claims is not at variance with the Halliburton decision in the slightest. The latter reaffirms the old doctrine that the elements of *any* combination claim *must be sufficiently named, described and pointed out* so that the public will know the scope of the monopoly claimed. In the words of *Bates v. Coe*, this particularity is necessary so that "other inventors may know what part of the field of invention is unoccupied. *Gill v. Wells*, 22 Wall. 27, 89 U. S. 711."

On pages 41 and 42 of his Brief Respondent quotes in full the claims in suit in *Morely Sewing Machine Company v. Lancaster* 129 F. 38, 263. Each of these claims, in addition to including "mechanisms" and "appliances", closes with the phrase "*substantially as set forth*" or "*as specified*" or "*as set forth*". These terminal clauses of course limit the claims which are otherwise in relatively broad language to *machines as described in the specification and drawings* of the patent in suit.

However, in summarizing Claim 1 of the *Morely Sewing Machine* case, Respondent at page 47 of his Brief, lists what he calls the "means elements" in Morely's Claim 1 as follows:

1. "button feeding mechanism"
2. "appliances for passing a thread, etc."
3. "feeding mechanism, etc."

Respondent completely neglects to also quote the restrictive terminal clause in Claim 1 of Morely which states "*substantially as set forth.*" This clause completely nullifies Respondent's contention that the Morely case is authority for "means" claims of the type appearing in the Gibbs patent.

Respondent gives similar treatment to the *Paper Bag* case with respect to which, on page 47 of his Brief, he states that Claim 1 contains as elements:

1. "means for operating said fingers at definite times, etc."
2. "operating means for the forming plate adapted to cause, etc."
3. "means to move the bag tube, etc."

Considering only this much of said claim, it is made to appear that this Court has broadly sanctioned functional claims.

However, if we read *all* of said claim, instead of just Respondent's outline thereof, we immediately see that it also includes a

"rotating cylinder provided with one or more pairs of side-folding fingers adapted to be moved toward or from each other, a forming plate also provided with side-forming fingers adapted to be moved toward or from each other, etc."

It is further specified in said claim that the operating means for the forming plate is

"adapted to cause the said plate to oscillate about its rear edge upon the surface of the cylinder during the rotary movement of said cylinder, the whole operating for the purpose of opening and forming the bottom of the bag tube."

Attention is particularly called to the fact that Mr. Justice McKenna in upholding the patent in the *Paper Bag* case stated that the pith of the invention was:

"the combination of a rotating cylinder with means for operating the forming plate in connection therewith, *limited however*, to means which cause the plate to oscillate about its rear edge on the surface thereof";

and that a

"folding plate and cylinder had never been combined before",

and hence that the court felt the lower courts were correct in considering invention to be involved and the claim not to be too broadly defined.

It is quite apparent therefore that neither the *Morely* case nor the *Paper Bag* case is authority for sustaining the *functional claims* here in suit.

The same is true in the case of *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, cited and quoted by Respondent on pages 47 and 48 of his Brief. A mere casual inspection of the Exhibit Supply Co. claim shows that the word "means" was modified and limited structurally as well as functionally, whereas in the Gibbs claims no such modification or limitation is present.

The Gibbs claims instead of being comparable to the *Exhibit v. Ace* claims, are strictly on all fours with the *Walker* claims in the *Halliburton* case. Just as the *Walker* claims were invalid for functional statements at their exact point of novelty, so are the Gibbs claims invalid for the same reason.

Such functionality in claims has been consistently condemned by this court. In the case of *United Carbon Company v. Binney & Smith Co.*, 317 U. S. 228, 55 U. S. P. Q.

381, this court, speaking through Mr. Justice Jackson, said with respect to R. S. 4888:

"So read, the claims are but inaccurate suggestions of the *functions* of the product and fall afoul of the rule that a patentee *may not broaden* his claims by describing the product in terms of *function*.

Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245; *General Electric Co. v. Wabash Corp.*, 37 USPQ 466; 304 U. S. 364." (Emphasis added.)

Respondent's Criticism of the Halliburton Decision.

Under Point IV of his Brief, Respondent first postulates a theoretical question and then uses this question as a springboard for arguing that the reasoning of this court in the *Halliburton v. Walker* case was erroneous.

Respondent states that if the Halliburton decision can be construed to bar what he calls "means" claims, it should be explained, clarified or distinguished. Respondent states that he does not believe this Court *meant* to rule out *all* combination claims in which the word "means" is used. He then asserts that Petitioner has, however, cited the Halliburton case to this effect. This assertion is erroneous.

Petitioner has brought the instant case to this Court because the courts below refused to recognize:

- (1) That the Halliburton decision was a restatement and particularization of well-settled law relative to functional claims, and
- (2) That the rule of the Halliburton case applied equally well to claims for a combination of mechanical and electrical elements as to a combination of mechanical and acoustical elements.

As a make-weight to his contention that the Halliburton decision is wrong Respondent points to the fact that Mr. Mattingly, one of the counsel of record herein, was the attorney for Walker in the Halliburton case and that in June,

1947, he filed an affidavit in support of an unrelated petition for certiorari, wherein he stated that in his opinion the court should clarify the Halliburton holding. Mr. Mattingly is accused of bad faith in now appearing as associate counsel in this case some two years after filing the above-mentioned affidavit.

Unfortunately, Mr. Mattingly is unable to reply, due to his untimely death on Thursday, September 29 of this year, the day before undersigned counsel first heard of said affidavit.

In view of the fact that opposing counsel has adverted repeatedly in his Briefs before this court to Mr. Mattingly's connection with this case it is thought that perhaps a short statement concerning Mr. Mattingly's activities herein will not be amiss at this point.

As mentioned, Mr. Mattingly argued the case for Walker against Halliburton, which case was first affirmed by a divided court, but upon rehearing was decided adversely to Walker by a majority of 8 to 1. Mr. Mattingly understandably felt that he should have won the Walker case. But as a good counselor he recognized the Halliburton v. Walker decision as the law of the land as applied to the circumstances of that case.

As mentioned by oposing counsel, Mr. Mattingly was the attorney for the Defendant Hicks in the case of Gibbs v. Hicks filed in the Southern District of California shortly prior to the instant case. Contrary to Mr. Mattingly's desires the Hicks case was settled by giving a Consent Judgment to the Plaintiff Gibbs. Prior to the entry of said Consent Judgment the Defendant Faulkner requested Mr. Mattingly to handle this case for him but Mr. Mattingly fearing a conflict of interest because Hicks and Faulkner were then competitors referred Mr. Faulkner to undersigned counsel. Upon the entry of the Consent Judgment in the Hicks case, the undersigned counsel *requested* Mr. Mattingly, who was very familiar with the Gibbs patent, to act

as expert witness in this, the Faulkner case. This Mr. Mattingly consented to do and did.

During the pendency of the appeal of this case in the Ninth Circuit Court of Appeals, undersigned counsel and Mr. Mattingly on July 1, 1948 formed a partnership for the practice of law under the firm name of Fulwider & Mattingly. Subsequent thereto this case was decided adversely to appellant-defendant by the Ninth Circuit Court of Appeals and a petition was presented to this court for a Writ of Certiorari. Inasmuch as undersigned counsel was not then admitted to the Bar of this Court, said petition was signed by Mr. Mattingly with the undersigned merely appearing as counsel. At that time the above-mentioned partnership of Fulwider & Mattingly was still in existence, *all as was well known to opposing counsel.*

The undersigned was admitted to practice before this Court on April 25, 1949 and subsequently thereto prepared Petitioner's Opening Brief herein.

Returning to the Halliburton decision itself, and Respondent's discussion thereof, it is thought that little more need be said.

That the Halliburton case might also have been decided on other grounds does not seem to Petitioner to be an adequate reason for this court's now reversing a decision that was rendered by a majority of 8 to 1. Whether or not other grounds existed for the Halliburton decision would seem to be beside the point.

The gist of Respondent's argument seems to be that this court did not correctly read the statute and that as a consequence thereof, or because of the inadvertence of counsel for Halliburton, the court quoted the wrong part of the statute in its decision.

However, Petitioner cannot see any clear distinction between such words as "full", "clear", "concise", "exact", "distinct", "definite", "certain" and the like. The statute says that the inventor shall *particularly point out and distinctly claim* his invention. In the Halliburton case it

is said that "this statutory requirement of *distinctness* and *certainty* in claims is important." Merely because this court in the same decision also said that the claims should be a *clear, concise and exact description* of the invention, would not seem to show any grievous error or misconception by the court of the meaning of the statute or the rules prohibiting functionality in claims.

We are unable to accept Respondent's premise that in the Halliburton case this court was misled, or misconstrued or ignored the language of the statute requiring the inventor to "*particularly point out and distinctly claim the invention*".

The Halliburton case when read as a whole, as it should be, is quite clear. The decision condemns the use of functional language in any claim where the sole novelty or essence of the invention is described in functional language. This is not a new rule. It is an old rule, merely restated in the Halliburton decision in terms which were peculiarly applicable to the facts of that case. The circumstance that those terms are also peculiarly applicable to the facts of this case, does not warrant counsel for Respondent in seeking to overturn the Halliburton decision.

Conclusion.

It is believed that the Briefs herein demonstrate the following:

- (1) That Respondent has avoided and declined to meet the real issues of this case.
- (2) That Respondent, recognizing that the claims in suit fall squarely within the condemnation of the Halliburton case, has dwelt principally upon ancillary issues.
- (3) That Respondent has made no answer to Petitioner's Point I, to wit, that the claims in suit are invalid because they define the only alleged novelty therein in functional terms.

- (4) That Respondent's attack on the Halliburton decision is predicated upon an erroneous hypothesis and is entirely outside the issues of this case.
- (5) That Gibbs' claim 3 exhibits no novelty whatsoever over the Nakashima patent unless "means for energizing" is limited to the relays R and associated armatures R' specifically shown in the Gibbs patent and included in claims 1, 2, 4 and 5 not here in suit.
- (6) That claims 6 to 10 display no novelty over the Nakashima patent other than that set forth in the functional statements describing the results to be accomplished by their interconnection.
- (7) That Respondent's statements in his Brief that the trial court resolved all conflicts of evidence in Respondent's favor are erroneous on their face in view of the fact that the trial court found claims 6, 7 and 8 not to be infringed by the new Fawn game.
- (8) That claim 9 is more restricted than claim 6, and in any event includes the same element present in claim 6 which caused the trial court to find claim 6 not infringed. Consequently, claim 9 and its dependent claim 10 cannot, as a matter of law be infringed by the new Fawn game.
- (9) That the concurrent Findings below are so clearly erroneous that they should be reversed and the Gibbs claims in suit held invalid for lack of novelty and invention.
- (10) That the claims in suit are clearly invalid for failure to particularly point out the invention as required by R. S. 4888, since they use conveniently functional language at the exact point of novelty.

(11) That the decision of the courts below should be reversed.

Respectfully submitted,

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